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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Miho WATANABE et al.

Group Art Unit: 1763

Application No.: 10/768,039

Examiner: A. OLSEN

Filed: February 2, 2004

Docket No.: 118506

For: CARBON NANOTUBE STRUCTURE, METHOD OF MANUFACTURING THE SAME, CARBON NANOTUBE TRANSFER BODY, AND LIQUID SOLUTION

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the February 16, 2006 Restriction and Election of Species Requirement, Applicants provisionally elect Group II, claims 16-31 and 33-66 for the Restriction Requirement, with traverse. In addition, Applicants provisionally elect claim 2 of Species Set I, claim 7 of Species Set II, and claim 8 of Species Set III, with traverse.¹

The Restriction Requirement alleged that Group I, directed to a carbon nanotube structure and a carbon nanotube transfer body, and Group II, directed to a process of making a carbon nanotube structure, are distinct because the process as claimed in Group II could yield

¹ During a February 28, 2006 telephone conference with Examiner Olsen, the Examiner acknowledged that the grouping of claims in the Restriction Requirement was incorrect, for example because claims 67-74 were in each of Groups I and II. The Examiner thus clarified the grouping of claims for the Restriction Requirement: Group I, claims 1-15, 32 and 67-74; Group II, claims 16-31 and 33-66; and Group III, claims 75-87.

a linear structure product rather than a mesh structure product as claimed in Group I.

Applicants disagree.

The claims of Group I recite a carbon nanotube structure having plural carbon nanotubes and cross-linked sites formed from plural chemical bonds between functional groups where each of the functional groups bonded to different carbon nanotubes of the plural carbon nanotubes at least on one end, wherein the plural carbon nanotubes constitute a mesh structure. The claims of Group II recite a method of manufacturing a carbon nanotube structure that includes supplying a base body with a liquid solution containing carbon nanotubes that have functional groups and cross-linking the plural carbon nanotubes to one another by causing the functional groups to form chemical bonds among themselves to thereby form a mesh structure of the carbon nanotube structure.

It is clear from the claim 16 that the process requires formation of a mesh structure rather than a linear structure. Thus, the process requires a mesh structure and cannot form a linear structure as alleged by the Patent Office. As such, no proper basis for restriction between Groups I and II has been established. Reconsideration and withdrawal of at least this aspect of the Restriction Requirement is respectfully requested.

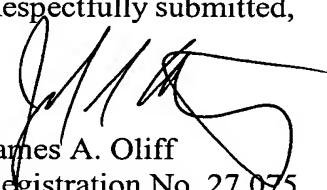
Regarding the Election of Species Requirement, Applicants submit that at least claims 1-6 are readable upon species I, at least claims 1, 6, 7, 9, 11 and 13 are readable upon species II, and at least claims 1, 6, 8, 10, 12 and 14 are readable upon species III. Further, Applicants submit that at least claims 1 and 16 are generic to all species.²

² During the telephone conference with Examiner Olsen, the Examiner acknowledged that the three sets of species set forth in the Requirement may not apply to all of the above groups. However, the Examiner requested elections be made even though all of the species were defined only with respect to the claims of Group I. Applicants note again that Group II is elected, and the election of species appears irrelevant with respect to the claims of Group II. The Group II claims are generic to all of the species.

It is also respectfully submitted that the subject matter of all claims and species is sufficiently related that a thorough search for the subject matter of any one Group of claims or species would encompass a search for the subject matter of the remaining claims or species. Thus, it is respectfully submitted that the search and examination of the entire application could be made without serious burden. See MPEP §803 in which it is stated that "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions" (emphasis added). It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office.

Thus, withdrawal of the Restriction and Election of Species Requirement is respectfully requested.

Respectfully submitted,


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